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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,033	10/22/2001	Patrick C. Kung	044574-5040	9303

9629 7590 06/24/2003

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EXAMINER
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LY, CHEYNE D

ART UNIT	PAPER NUMBER
1631	11

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/830,033	KUNG ET AL.
	<b>Examin r</b> Cheyne D Ly	<b>Art Unit</b> 1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**P r i d f r R ply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three-months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on April 28, 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 27-34,68-75 and 77-82 is/are pending in the application.
- 4a) Of the above claim(s) 77-82 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 27-34 and 68-75 is/are rejected.
- 7) Claim(s) 32-34 and 75 is/are objected to.
- 8) Claim(s) 27-34,68-75 and 77-82 are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
    If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)                  4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)                  5)  Notice of Informal Patent Application (PTO-152)  
 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,7,8.                  6)  Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's election with traversal of Group II, claims 27-34, 68, 69, 70-75, and 77-82, Paper No. 10, filed April 28, 2003, is acknowledged.
2. The traversal is on the ground(s) the common technical feature is evaluating herbal compositions using marker data, therefore, meets the PCT Rule 13.1 requirement. This is not found persuasive because Group I-VI drawn to different methods of evaluating an herbal composition which have different special technical features. Each special technical feature directed to their respective methods defines a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. It is acknowledged that the commonality of the Groups is the herbal composition, however, the special technical feature directed to each invention causes them to be not linked as to form a single general inventive concept under PCT Rule 13.1.
3. The requirement is still deemed proper and is therefore made FINAL.
4. Claims 77-82 have been withdrawn due to being not directed to the elected group.
5. Claims 27-34, 68, 69, and 70-75; species: the post-harvest treatment of one or more of the individual herbs in the herbal composition, physiological responses, and cells, are examined on the merits.

### **Information Disclosure Statement**

6. Documents citing "Database Online" and International Search Report for PCT US01/07608 in the information disclosure statement, Paper No. 8, filed May 14, 2003, have not been considered because the "Database Online" documents do not have publication dates and the International Search Report for PCT US01/07608 is not published.

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7. Documents citing the International Search Report for PCT US99/24851 in the information disclosure statement, Paper No. 5, filed December 27, 2001, has not been considered because the International Search Report for PCT US99/24851 is not published.

### **SPECIFICATION**

8. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### **OBJECTIONS**

9. Claims 32-34, and 75 are objected to due to having non-elected subject matter; therefore, withdrawn from consideration.

### **CLAIM REJECTIONS - 35 U.S.C. § 112, SECOND PARAGRAPH**

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 28 and 30-33 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Specific to claim 28, steps (b) and (c), Applicants use the abbreviations of HBR. Abbreviations in claims are vague and indefinite unless accompanied by the full name, usually in parentheses.

13. Specific to claims 30-33, line 1, these claims are vague and indefinite because they are dependent from cancelled claims.

### **CLAIM REJECTIONS - 35 USC § 102**

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 27-34, 68, 69, and 70-75 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schena et al. (1996).

3. Schena et al. discloses a method for using microarrays to examine the physiological response of cells such as heat shock response in cultured human T (Jurkat) cells under control, heat-treated, and phorbol ester treatment. Further the data generated from the said method are analyzed and recorded with the National Institutes of Health IMAGE software (page 10615, column 1, 1-21), as in claims 27, 28, 33, 34, 69, and 75. A reference by Erickson et al. is used not as prior art but only to disclose a herbal composition collected from King George River in northwestern Australia (derived from *E. agallocha*, phorbol ester, has been identified to have cytoprotective properties against HIV. The herbal composition is extracted from a freezed-dried plant sample, (page 769, column 1, lines 28-29 to column 2, lines 1-6; and page 771, column 1, Experimental section), as in claims 31 and 32.

4. “Detectable expression was observed for all 15 of the heat shock and phorbol ester-regulated genes...Gene encoding  $\beta$ -actin and cytochrome c oxidase, the two most highly expressed of the 15genes in Jurkat cells (Table 2) (page 10617, column 2, lines 11-20), as in claims 29, 30, 68, and 70-74.

## **CONCLUSION**

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5. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (703) 308-3880. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

8. Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

C. Dune Ly  
6/18/03

*Ardin H. Marschel*  
ARDIN H. MARSHEL  
PRIMARY EXAMINER